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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,542	12/28/2001	Loris Giuseppe Navoni	32079-00083 USPX	4704

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EXAMINER
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LAO, SUE X

ART UNIT	PAPER NUMBER
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2194

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/035,542

Applicant(s)

NAVONI ET AL.

Examiner

Sue Lao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1, 2, 5-15 are pending. This action is in response to the amendment filed 5/16/2005. Applicant has canceled claims 3 and 4 and added claims 6-15.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1, 2, 6-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claims 1, 6, 10, 13 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claims 1, 6, 10, 13 do not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998).

MPEP 2106. State Street required transformation of data by a machine before it applied the “useful, concrete, and tangible test.” However, State Street does not hold that a “useful, concrete and tangible result” alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

5. Claims 1, 2, 5, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al (U S Pat. 6,192,255) in view of Tachibana et al (U S Pat. 6,055,595) and Greanias et al (U S Pat. 5,157,384).

As to claim 1, Lewis teaches a method of expanding the functional capabilities of portable electronic host devices (multiple purpose communication device 50) with user-friendly modes, wherein a host device (50) has a quick-connect functional expansion module (application modules 100, col. 14, lines 43-48) associated therewith, comprising: on a first installation of the given functional expansion module in the host device, performing a series of checking operations automatically (functions such as authentication, col. 16, line 52 – col. 17, line 20). Lewis further teaches expansion user interface commands (user’s voice command, col. 4, lines 40-54) and an application of the host device (resident applications, col. 3, lines 19-41) controllable by the functional expansion module.

While recognizing each other is necessary for the expansion module to work with the host device, Lewis does not explicitly teach at each installation of a given functional expansion module, the module and the host device recognizing each other. Lewis does not teach expansion user interface, to identify an application of the host device controllable by the functional expansion module and determine vocabulary data defining user interface command correspondence between expansion user interface commands and application commands which designate software actions to be performed by the application; and following a given application provided by the host device being selected for activation, storing the vocabulary data in the host device for host device access at a subsequent installation of the functional expansion module.

Tachibana teaches a method of expanding the functional capabilities of portable electronic host devices (portable information apparatus, fig. 1, 2) with user-friendly

modes, wherein a host device (computer, fig. 2) has a quick-connect functional expansion module (PC card 171) associated therewith supporting an expansion user interface (configurable via user interface shown in fig.s 9 and 10), including, at each installation of a given module (PC card 171), the module and the host device recognizing each other (recognize insertion, col. 6, lines 27-37).

Tachibana further teaches identifying an application of the host device controllable by the functional expansion module (set card/program registration information to registry 32) (program information, fig.s 8C, 8E-8G), and following a given application provided by the host device being selected for activation (program information, fig.s 8C, 8E-8G), storing user profile data in the host device for host device access at a subsequent installation of the functional expansion module (set registry information, col. 8, line 56 – col. 9, line 37).

Therefore, it would have been obvious to include the steps of recognizing and storing into Lewis. One of ordinary skill in the art would have been motivated to combine the teachings of Lewis and Tachibana. Lewis teaches multiple expansion modules may be installed to offer a wide range of functions (col. 9, lines 1-18). One of ordinary skill in the art would recognize that managing configurations under such situations increases user's burden. Tachibana teaches a mechanism (registry, fig. 7) to manage configuration information (card/program registration information, col. 7, line 66 – col. 8, line 8) desirable under such situations to reduce the user's burden (col. 1, lines 40-67). Therefore, one of ordinary skill in the art would have been motivated to use the mechanism as taught by Tachibana to manage the configuration information in Lewis.

Lewis as modified by Tachibana does not teach determining vocabulary data defining user interface command correspondence between expansion user interface commands and application commands which designate software actions to be performed by the application, nor the stored user profile data includes the vocabulary data.

Greanias teaches expanding the functional capabilities of host devices (advanced user interface,), including determining vocabulary data (interface profile, user profile) defining user interface command correspondence (map of input messages

to application commands, col. 4, lines 6-9; fig. 5) between expansion user interface commands (alternative input, including one connected to voice sensor, fig. 3) and application commands (commands usable by the application) which designate software actions to be performed by the application (steps 229, 231, fig. 7). Greanias further teaches storing user profile data which includes vocabulary data / correspondence (table shown in fig. 5). See col. 3, line 49 – col. 4, line 13.

Therefore, it would have been obvious to include the steps of determining and storing vocabulary data into Lewis as modified. One of ordinary skill in the art would have been motivated to combine the teachings of Lewis as modified and Greanias because this would have allowed a relatively unsophisticated user to select programs and devices and construct a user interface designed particularly to his needs (col. 3, lines 38-41) which would have further the goal of easy user customization of Lewis as modified.

It is noted that the limitation 'so as to obviate the need to subsequently perform the series of checking operations for that functional expansion module' is interpreted as the result, which would have been the consequence of operations taught by Lewis as modified by Tachibana and Greanias.

As to claim 2, Lewis as modified by Tachibana teaches listing applications installed in the host device (Card aid screens); checking said function expansion module for compatibility with each host device application [inherent/necessary to the programs in the list of to function]; searching for required modes to implement the expansion user interface of the function expansion module (list of programs/options); and constructing the "vocabulary" data of correspondence between (Tachibana, set card/program registration information, col. 7, line 66 – col. 9, line 37; fig.s 7-9) (Greania, interface profile, user profile, see discussion of claim 1).

As to claim 5, Lewis as modified teaches a system, comprising:

a portable electronic host device with expanded function capability (Lewis, multiple purpose communication device 50) having operating system supporting an application controlled through a host user interface (Greanias, fig. 2, 3); and

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a quick-connect function-expanding module, comprising: a host device loading and connecting program (Lewis, utility program, col. 3, lines 23-27); an expansion module control program (Tachibana, Card Aid / utility program, col. 5, line 65 – col. 6, line 21); and an API for the module to dialog with the operating system of the host device (Tachibana, WM\_devicechange(), col. 5, line 65 – col. 6, line 21);

wherein the host device stores tables of correspondence between the application and the function expanding module defining user interface command correspondence between expansion user interface commands and application commands which designate software actions to be performed by the application (Greanias, interface profile, user profile, see discussion of claim 1), the stored tables accessed at each installation of the module (Greanias, steps of fig. 7) through the expanded function capability to the portable electronic host device (Lewis, application modules, discussion of claim 1).

As to claim 13, note discussion of claim 1 for defining and storing and providing/supporting. Lewis as modified further teaches receiving a functional expansion module by a portable electronic device (Lewis, fig. 5) and identifying applications resident on (resident applications) which make use of a user interface in their functional operation (Lewis, col. 3, lines 19-41), each identified resident application having an application user interface (Greanias, fig. 6). Note discussion of claim 1 for a motivation to combine.

As to claims 14, 15, Lewis as modified teaches (Greansia) voice recognition module (38, 66), correspondence linking recognized user voice commands to application user interface (fig. 5, 1<sup>st</sup> and 3<sup>rd</sup> col.s), commands mapped (map input messages to application commands, col. 4, lines 6-9; fig. 5). Note discussion of claim 1 for a motivation to combine.

As to claim 10, note discussion of claim 13, and Lewis as modified further teaches (Greanias) certain received user commands (fig. 5, 1<sup>st</sup> col.), certain commands to which the resident application responds (fig. 5, 3<sup>rd</sup> col.).

As to claim 11, note discussion of claim 14.

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As to claim 12, note discussion of claim 10, and the equivalence of certain commands designating certain software actions / certain commands to which the resident application responds.

6. Claims 6-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and subjected to a final search update.

7. Applicant's arguments filed 5/16/2005 have been considered but are moot in view of the new ground(s) of rejection. Applicant amended claims have added limitations not previously recited, thus, requiring a new grounds of rejection.

The amended expansion user interface and correspondence between expansion user interface commands and application commands are met by Greanias et al, as detailed in the rejections above.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.




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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 17, 2005



**SUE LAO**  
**PRIMARY EXAMINER**